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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/811,360	03/16/2001	Eugene M. Wolf	2502440-991501	7725

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EXAMINER

BLANCO, JAVIER G

ART UNIT PAPER NUMBER

3738

DATE MAILED: 04/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/811,360	Applicant(s) WOLF, EUGENE M.	
	Examiner Javier G. Blanco	Art Unit 3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4-6, 8-25, 28-39, 41-43, 50-52, 54, and 55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4-6, 8-25, 28-39, 41-43, 50-52, 54, and 55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's amendment of claims 8, 25, 31, and 42 in the reply filed on January 11, 2006 is acknowledged.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 4-6, 8-25, 28-39, 41-43, 50-52, 54, and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kinnet (US 4,550,450 A; cited in Applicant's IDS) in view of Pascarella et al. (US 5,326,366 A; cited in Applicant's IDS), Swanson et al. (US 4,042,980 A; cited in Applicant's IDS), and Chiron-Werke (DE 1164019; cited in Applicant's IDS).

As seen in Figures 1, 2, 5, and 6, Kinnet discloses a total shoulder arthroplasty apparatus comprising a stemless, partial humeral head fixation (humeral component 10) for coupling to a cut humeral surface (see Figure 1); wherein the partial humeral head fixation includes a partial humeral head (main body portion 20) including a base surface (= root or base wall) and a rotationally-stabilizing (see column 4, lines 40-42) base extension (fixation post/keel 21) protruding therefrom for impaction into a cancellous region of the cut humeral surface (see Figure 1; see entire document). Kinnett also discloses the claimed method of implanting the total shoulder arthroplasty apparatus (see columns 5-7). Kinnett further discloses the use of a template

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punch (see column 6, lines 40-51). The base extension is impacted and non-intramedullary (see column 7, lines 13-27; see entire document).

Although Kinnett shows the fixation post/keel 21 as having a slight depression (see Figure 1) and also that the fixation post/keel “provides increased mechanical advantages against torque and provides increased surface area of fixation” (see column 4, lines 40-42) and also that it prevents dislocation (see column 4, lines 50-53), he/she does not particularly disclose the base extension as including a plurality of fins forming a cruciate/cruciform shape.

However, from a structural point of view, attachment/anchoring means (anti-rotation means) for bone engaging orthopedic implants comprising a cruciate/cruciform shape are well known in the art. For example, Pascarella et al. ‘366 teach a bone engaging orthopedic implant/device (see Figures 3 and 5) comprising a base extension (stem 30) including a plurality of fins (planar, triangular fins 32, 34, 36, and 38) for anchoring in cancellous bone (see column 3, lines 26-29). The orientation of said fins forms a cruciate/cruciform shape (Figure 5) in order to provide maximum anchorage of the implant, to prevent rotation of the implant, and to provide minimal disturbance of the endosteal blood supply of the anchoring area (see column 3, lines 49-57). Therefore, it would have been obvious to a person having ordinary skill in the art to have combined the teaching of a base extension (attachment/anchoring means) including a plurality of fins forming a cruciate/cruciform shape, as taught by Pascarella et al. ‘366, with the prosthetic orthopedic device of Kinnett, in order to provide maximum anchorage of the implant, to prevent rotational motion of the implant relative to the anchor area/site (i.e., cut humeral surface), and to provide minimal disturbance of the endosteal blood supply of the anchoring area.

Kinnett does not disclose the fixation keel 21 as been linear. However, Swanson et al. and Chiron-Werke teach at least one linear fin extending from the base of the prosthetic orthopedic device in order to anchor the prosthetic orthopedic device and prevent or limit rotational motion of it relative to the anchor area/site (see Swanson et al.'s column 3, lines 3-8; see Chiron-Werke entire document). Therefore, it would have been obvious to a person of ordinary skill in the art to have combined the teaching of at least one linear fin extending from the base of the prosthetic orthopedic device, as taught by Swanson et al. and Chiron-Werke, with the prosthetic orthopedic device of Kinnett, in order to anchor the prosthetic orthopedic device and prevent or limit rotational motion of it relative to the anchor area/site (i.e., cut humeral surface).

Response to Arguments

4. Applicant's arguments filed January 11, 2006 have been fully considered but they are not persuasive:

The Declaration of Dr. Eugene M. Wolf, and the Declaration of Dr. Glenn B. Pfeffer have been considered but were ineffective to overcome the 103(a) rejection based on Kinnet (US 4,550,450 A; cited in Applicant's IDS) in view of Pascarella et al. (US 5,326,366 A; cited in Applicant's IDS). It has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, both references disclose joint prostheses/implants. The references have analogous subject matter since each disclose attachment/anchoring means to attach/anchor said prosthesis to a joint. In

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other words, both references teach bone implants, and how said bone implants will be held to a joint end of a bone. The strength of the 103(a) rejection is stronger than that of the declarations.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Javier G. Blanco whose telephone number is 571-272-4747. The examiner can normally be reached on M-F (9:30 a.m.-7:00 p.m.), first Friday of the bi-week off.

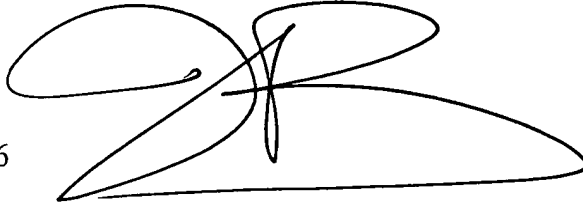

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone numbers for the organization where this application or proceeding is assigned is 703-872-9306 for regular communications and After Final communications. Any inquiry of a general nature or relating to

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the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

JGB

March 30, 2006

A large, stylized handwritten signature in black ink, consisting of several loops and a long horizontal stroke at the bottom.A handwritten signature in black ink, appearing to read 'D. Willse', written in a cursive style.

David H. Willse
Primary Examiner